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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/899,661	07/05/2001	Winthrop A. Eastman	0483FV.044665	2676

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EXAMINER

WEBB, JAMISUE A

ART UNIT PAPER NUMBER

3629

DATE MAILED: 03/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/899,661

Applicant(s)

EASTMAN, WINTHROP A.

Examiner

Jamisue A. Webb

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,11,13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,11,13 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 3, 11, 13 and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 has added two limitations which are not supported by the original disclosure “such means occupying none of the space within the container in which the goods being shipped are contained” and monitoring via “wireless communications”. The specification discloses a means for thermally managing the contents of the container, but never specifically discloses that the means cannot be located within the container. The disclosure also discloses monitoring tracking data which can be temperature and location, but never discloses the monitoring is done via wireless communications”.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3629

4. Claims 1, 3, 11, 13 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 1 recites the limitation "the containers". There is insufficient antecedent basis for this limitation in the claim. Is this the container in the receiving step, or the containers in the ascertaining step? Furthermore, previously in the claim it states, "one or more insulated shipping containers", which allows there to be only one container. Therefore, it is unclear what "the containers" is referring to, if there is only one.

6. Claim 1 recites the limitations "the proper logistical means" and "the logistical solution". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

Claims 1, 3, 11, 13 and 14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis for this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences,

Art Unit: 3629

for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use or advance the technological arts.

In the present case, claims 1, 3, 11, 13 and 14 only recite an abstract idea. The recited steps of merely receiving an order, ascertaining the number of containers, loading the goods, delivering the goods, monitoring the goods and retrieving the container, does not apply, involve, use or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pen and paper. These steps only constitute an idea of how to ship and monitor temperature sensitive goods.

Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

In the present case, the applicant has added into the claims "monitoring via wireless communications real-time data" but never collects, stores or even uses the data in the method, it merely monitors it. Furthermore, the applicant has added wireless communication to the claim, but a person talking out loud to another person and reading the temperature from a thermometer outside is a form of wireless communication, therefore, the claims do not apply, involve, use or advance the technological arts.

Additionally, for a claimed invention to be statutory, the claimed must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces containers that are used to ship temperature-sensitive goods, where the containers are reusable (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1, 3, 11, 13 and 14 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3, 11, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murray (6,536,189) in view of Retallick et al (6,189,330).

9. With respect to Claim 1: Murray discloses the following steps:

- a. receiving order information for a shipping container (1st step in Figure 1), wherein each container has a means for thermally managing the contents of the container (134) located on the outside of the container (Figure 9);
- b. ascertaining an appropriate number of containers (Column 4, lines 46-54),
- c. determining alternate solutions (1st Step in Figure 1),
- d. customer selecting means of delivery (1st Step in Figure 1),
- e. customer implementing a shipping schedule (1st Step in Figure 1),
- f. deliver goods to desired location (5th Step in Figure 1),

Art Unit: 3629

- g. monitor delivery (3rd step in Figure 1) and temperature (Column 12, line 59 to Column 13, line 26) and all monitor reporting can be done via wireless communications (Column 6, lines 8-12),
- h. maintain tracking data (7th Step in Figure 1),
- i. unloading container (6th Step in Figure 1),

However, Murray fails to disclose delivering the containers to the customer before loading, the customer loading the container with goods and then retrieving and reusing the containers. Retallick discloses a reusable temperature sensitive container for delivering temperature sensitive goods (see abstract) that comprises the steps of:

- j. providing the containers to the customer before loading (column 4, lines 5-12),
- k. customer loading of the containers (Column 4, lines 5-24),
- l. retrieving container after use and making it ready for future use (column 4, lines 14-24).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the container of Murray to be delivered to the customer and to be recycled according to Retallick, in order to reuse and refurbish the containers for future use. (See Retallick, columns 11 and 12).

- 10. With respect to Claim 11: See Retallick, column 4, lines 18-24.
- 11. With respect to Claims 13 and 14: See Murray, Column 4, line 55 to Column 5, line 4.
- 12. With respect to Claims 3: Murray discloses the claimed invention, but he fails to specifically disclose the delivery, monitoring and tracking down by the customer. At the time the invention was made it would have been an obvious matter of design choice to a person of

Art Unit: 3629

ordinary skill in the art to have the delivery, monitoring and tracking be down by either the customer or a 3rd party because Applicant has not disclosed that these being down by the customer or 3rd party provides any advantage or solves any stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the provider doing the delivering, monitoring and tracking because the steps of delivery, tracking and monitoring are still performed, they are just performed by a different entity, therefore would work equally as well.

Response to Amendment

13. The amendment filed 12/13/04 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: See above 112 1st paragraph rejection for reasoning in regards to the "new matter".

Applicant is required to cancel the new matter in the reply to this Office Action.

Response to Arguments

14. Applicant's arguments filed 12/13/04 have been fully considered but they are not persuasive.

15. With respect to Applicant's argument in regards to the 35 USC 101 rejection: The applicant has argued that the claims now reside in the technological arts due to the fact that the container has a means for thermally managing the contents of the container which is a heat sink

Art Unit: 3629

material and monitoring, via wireless communications, of real-time data regarding temperature events within the container and the location of the container. The examiner has maintained this rejection, due to the fact that where as there may be statutory subject matter involved in the method, but the method itself does not advance the technological arts. Thermally managing the contents of the container is done by a person, who heats or chills a heat sink material.

Monitoring, via wireless communication, can also be done by a user, if a user reads a thermometer that is located on the outside of the container and verbally reports the temperature to a person standing next to him/her. The claims are stating the use of a method of performing a function, this method must be within the technological arts, everything in the method can be done by hand (not by use of a computer) by a person, therefore the 101 rejection stands as stated above.

16. With regards to Applicant's arguments that Murray and Retallick do not disclose monitoring, via wireless communication, real-time data regarding temperature events occurring within the containers and the geographic location of the containers": Murray discloses a temperature alarm that a person can monitor, physically view. If the user looks at the alarm, then it is monitored in a real-time basis. The claim does not state that the real-time data is collected, only that is monitored, therefore if a person visually monitors it, then the examiner considers that to be a form of monitoring. If the person is visually monitoring the package, then person would be monitoring the location also. The applicant has argued that Murray does not disclose the monitoring process for temperature events and location, in real-time, along the delivery process. First of all, the limitation of "along the delivery process" is not claimed. Second, Murray discloses monitoring at the start and finish, which is along the delivery process.

Art Unit: 3629

17. With respect to Applicant's argument to "means occupying none of the space within the container in which the goods being shipped are contained": Murray discloses the use of the temperature sensor, which can be a means for thermally managing the contents of the container, but informing a user if the temperature has gone above or below a certain temperature, which the examiner considers to be a form of thermally managing the contents of the container. And the sensor is placed on the outside of the container, therefore not occupying any space. The applicant has indicated that the specification has support for the "means occupying none of the space within the container in which the goods being shipped are contained". The examiner disagrees that there is support in the specification for this limitation. The background of the invention may indicate that a problem with the prior art, and may say that the application overcomes the problems of the prior art, however the specification must still have positive support for each limitation claimed. The background of the invention states that the problem of the prior art is that it is unclear as to how many heat sink materials to include, but the background merely states that it is difficult to decide how much to put in. Nowhere in the background does it lead to or state that none of the heat sink material will be located within the space of the container. For these reasons, the rejections stand as stated above.

Conclusion

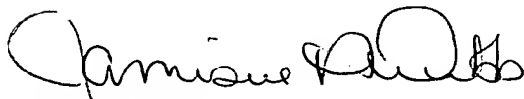
18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

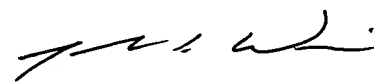
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Webb whose telephone number is (703) 308-8579. The examiner can normally be reached on M-F (7:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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